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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/332,063	06/14/99	HOLMGREN	L 3362-0101P

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EXAMINER

HARRIS, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/332,063

Applicant(s)
Holmgreen & Troyanovsky

Examiner
Alana M. Harris, Ph. D.

Group Art Unit
1642



☒ Responsive to communication(s) filed on January 10, 2001.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1 and 3-33 is/are pending in the application.

Of the above, claim(s) 9-29 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-7, and 30-33 is/are rejected.

☒ Claim(s) 8 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

DETAILED ACTION

Response to Amendment

1. Claims 1 and 3-33 are pending.

Claims 1, 3 and 28-30 have been amended.

Claims 9-29, drawn to non-elected inventions are withdrawn from examination.

Claims 1, 3-8 and 30-33 are examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restriction

3. The Applicants' have acknowledged the *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) in regard to their claims 28 and 29 which are directed to an invention that is independent or distinct from the invention originally claimed. While the Examiner concurs with the guidelines of the case law, the **product claims must be first found allowable** and then a method or conventional process could be patented if it were limited to making or using a nonobvious product. At this point in prosecution this is not the case.

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Withdrawn Objections and Rejections

Claim Objections

4. The objection of claims 28-30 under 37 CFR 1.75(c) as being in improper dependent form is withdrawn in view of Applicants' amendments to the claims.

Claim Rejections - 35 U.S.C. § 112

5. The rejection of claims 1-8 and 31-33 under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement commensurate with the scope of the claimed invention is withdrawn in view of Applicants' arguments.

Claim Rejections - 35 U.S.C. § 102

6. The rejection of claim 1 and 30 under 35 U.S.C. 102(b) as being anticipated by Petersen et al. (Journal of Biological Chemistry 205(11):6104-6111, 1990) is withdrawn in view of Applicants' amendment. However, should Applicant remove the proviso regarded as new matter this rejection will be reinstated.

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New Grounds of Objection and Rejection

Claim Rejections - 35 U.S.C. § 112

7. Claims 1, 3-6 and 30-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. THIS IS A NEW MATTER REJECTION. The added material which is not supported by the original disclosure is as follows: "...wherein said protein does not cleave plasminogen kringle domains." Applicants have pointed out page 5, line 31-page 6, line 3 for support of this proviso. Applicants have also expressed that "...these lines do not provide explicit support for this added limitation...". The Examiner finds this to be true as well.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 U.S.C. § 102

8. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 5,916,572 (filed November 14, 1995). Sequence number 54 in U.S. Patent 5,916,572 discloses five contiguous amino acid residues of SEQ ID NO:2 that is capable of binding an N-terminal fragment of plasminogen.

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Allowable Subject Matter

9. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Claims 3-6 and 31-33 are free of the art.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (703)306-5880. The examiner can normally be reached on Monday through Friday from 6:30 am to 3:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D., can be reached on (703)308-4310. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0196.

Alana M. Harris, Ph.D.
Patent Examiner, Group 1642
March 26, 2001

